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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,251	09/10/2007	Thomas Bretschneider	2400.080000/JMC/CMB	7404
26111 7590 03/24/2010 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
HABTE, KAHISAY				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
03/24/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/594,251

Applicant(s)

BRETSCHNEIDER ET AL.

Examiner

Kahsay T. Habte

Art Unit

1624

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-7, 27, 28, 30-33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 27, 28, 30-33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date 6/26/07 & 11/9/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-7, 27-28, 30-33 and 35 are pending in this application.

Election/Restriction

2. Applicant's election with traverse of Group III in the replay filed 03/10/2010 is acknowledged. The traversal is on the ground(s) that the "instant application do not qualify as a 'clear case' of lacking unity of invention. Each claim shares the special technical feature of being related to 2,4,6-diphenyl substituted ketoenol compounds". The examiner disagrees with applicant's argument. There is no unity of invention between Groups I-XI because the inventions do not relate to a single general inventive concept under PCT Rule 13.1 and PCT Rule 13.2. The special technical feature of Group I is a 1,3-thiazine ring (six-membered ring with N and S at 1,3-positions) that is not present in the special technical feature of Groups II-XI. The special technical feature of Group II is a pyran ring (six-membered ring with one oxygen) and this is not present in other groups. The special technical feature of Group III is a pyrrolidine ring (five-membered ring with one N) and this special technical feature is not present in the special technical feature of Groups I-II or Groups IV-XI. The special technical feature of Group IV is a furan or a thiophene ring (five-membered ring with one O or one S) and this is not present in the special technical feature of other groups. The special technical feature of Group V is a cyclohexane or a cyclopentane ring (no heteroatoms in the ring) and this special technical feature is not present in Groups I-IV or Groups VI-XI. The special technical features of Groups VI-X are different from the special technical

features of Groups I-V, since they have no ring that is attached to the phenyl (no CKE present). The special technical feature of Groups VI-XI is different one from the other, since they are drawn to different chemical structures. For example, the special technical feature of Group VI is an amide derivative attached to the phenyl ring and is different from the special technical feature of other groups. Like wise, the special technical feature of Group VII is an ester derivative attached to a phenyl ring, the special technical feature of Group VIII is acid halide derivatives, the special technical feature of Group IX is ketone derivatives and the special technical feature of Group X is acid derivatives. Furthermore coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group I would include search of class 544, the search for the invention of Group II would include search of class 549 and the search for the invention of Group VI would include search of subclass 564. Therefore, coexamination of each of these additional inventions would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

Information Disclosure Statement

4. Applicant's Information Disclosure Statement, filed on 06/26/2007 and 11/09/2006 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-6 and 27-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6-8 of U.S. Patent No. 6,358,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the instant claims and claims 1-3 and 6-8 of U.S. Patent No. 6,358,887 when formula (I) in '887 is defined as: X = halogen, Z = alkoxy and Y = alkyl.

7. Claims 31-33 and 35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,432,225. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is significant overlap between the instant claims and claims 1-4 of U.S. Patent No. 7,432,225.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 27-28, 30-33 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "A and D together with the atoms to which they are attached...or unsaturated cycle which optionally (only in the case of $\text{CKE} = 1$) contains at least one heteroatom" is no clear. Can A and D together form a cycloalkyl? How is $\text{CKE} = 1$ (elected invention) different from the other definitions of A and D?

Note that for the purpose of the examination, the examiner assumes that A and D would only form a saturated or unsaturated cycle with at least one heteroatom.

Claim Objections

9. Claim 31 is objected to because of the following informalities: the recitation of "general formula" is not specific. A formula should be specific such as formula (I), formula (a), etc. and not general. It is recommended that applicants delete "general" to overcome this rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9:00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (571) 272-0661. The fax phone

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number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kahsay T. Habte/
Primary Examiner, Art Unit 1624

March 24, 2010